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Patent
Attorney Docket No. ITW7510.074

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of : Stein et al.
Serial No. : 10/605,546
Filed : October 7, 2003
For : Method and Apparatus to Adaptively Cool
A Welding-Type System
Group Art No. : 1725
Examiner : Kerns, K.

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REQUEST FOR RECONSIDERATION OF PETITION FILED SEPTEMBER 22, 2005

Dear Sir:

Responsive to the Decision on Petition of January 3, 2006, Petitioner hereby requests reconsideration of the Petition filed September 22, 2005 and entry and consideration of the following remarks.

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REMARKS

In the Petition of September 22, 2005, Petitioner requested review of the propriety of the finality of the Office Action of July 19, 2005 and relief therefrom. In the Decision of January 3, 2006 (hereinafter the Decision), the Office denied Applicant's petition in maintaining that the finality of the Office Action of July 19, 2005 is proper. The Decision includes several factual errors as well as a conclusion that is divergent from published Office procedure as set forth in several decisions of the Board of Patent Appeals and Interferences. Accordingly, Petitioner requests reconsideration of the Petition of September 22, 2005.

Clarification of Factual Assertions

Although Petitioner does not necessarily disagree with any of the individual statements in the summary of the prosecution history set forth in the second paragraph of the Decision, Petitioner notes that the several facts have been omitted. For Example, the Decision states, "Among the rejections was a rejection under 35 USC 102(b) over French Patent 2,536,320 which was cited by Applicants in an IDS." Decision, pg. 1, ¶2. Applicant cited the '320 Patent in the IDS of December 7, 2004. Therein, Applicant indicated that the '320 Patent was cited and provided to the Office under 37 C.F.R. §1.97(e)(1) as being first cited in a communication from a foreign office in a counterpart foreign application. The relative importance of this clarification is discussed further below.

The Decision states that "the examiner relied upon an English language abstract, a partial oral translation, and the figures of the reference to support the position of the rejection." Decision, pg. 2, ¶5. Although true, this assertion also fails to indicate that the examiner never communicated to Applicant what "few French words" were translated from the reference and relied upon to support the rejection of the claims. Rather, the examiner cited to the English abstract, the figures, and the entirety of the French language document to support the rejection. The Decision maintains that this clearly communicates the Office's position to an applicant. As argued further below, Petitioner cannot agree that a rejection, supported in part by a document in a foreign language, clearly communicates the propriety of the Office's position or affords an applicant an objective opportunity to respond thereto.

The Decision repeatedly asserts that Applicant did not respond to the rejection based on the '320 Patent. The Decision states that "Applicants responded to the office action on May 16, 2005" and that "in the response, it was argued that the reliance upon an abstract is improper and it was requested that the examiner provide a translation and rely upon the entire French document in any subsequent rejections." Decision, pg. 1, ¶2. The Decision further states that "after the

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non-final office action was sent, applicants had the opportunity to respond to these positions [based on the '320 Patent] but merely elected to argue that the examiner improperly rejected the claims over an abstract and that said abstract did not meet the claims." Decision, pg. 2, ¶5. Although factually accurate, this statement omits reference to that portion of the Response of May 16 wherein Applicant argued that that which is called for in the claims is not disclosed, taught, or suggested in that portion of the reference available for Applicant's review, i.e. the English language abstract. Response of May 16, 2005, pg. 9, ¶6. Petitioner did not merely object to the reliance on the foreign reference but argued that the English language abstract failed to disclose that which the examiner asserted as being disclosed. If the English translation is not provided, an Applicant has no obligation to respond to it. That is, Applicant responded to the rejection set forth by the Office in as complete a manner as the rejection was set forth in English and supported by an English reference.

Remarks

In summarizing the Petition, the Office states that "Petitioner argues that it is not proper to maintain a rejection that was based in whole or in part on a non-English language document and make such an action final." Decision, pg. 2, ¶1. In fact, Petitioner argued that a rejection which relies entirely, or in part, on a document that is in a foreign language is improper. Petitioner believes that the Office does not meet its requirement of providing an Applicant with the information and references required to respond to an Office Action when the reference is in a foreign language. Subsequently providing the translation in a final office action does nothing to "un-ring the proverbial bell" of the incomplete nature of the first office action. Petitioner believes that a court would not find that an applicant has been afforded any degree of equity when faced with a rejection which relies in part upon a non-English language document. Petitioner's citations to MPEP §2271 in the Petition of September 22, 2005 were to elucidate the equity which is engrained within the provisions of the MPEP. For Example, the same concept of fair dealing is shadowed in those provisions related to §102(e) art wherein the reference must be published in English and the provisions articulated in MPEP §§200 and 600 wherein an Applicant must provide an English language translation of a foreign language document incorporated by reference. As an applicant cannot shift the burden to the Office to acquire English language translations of relied upon foreign language documents, equally the Office cannot shift its burden to an applicant.

The Decision cites to MPEP §901.05(d) with emphasis upon the authorization provided therein that "Examiners may request written translations at any point in the examination process,

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at the discretion of the individual examiner, but are encouraged to use oral assistance and/or language reference resources as much as possible in the early phases of examination.” Decision, pg. 2, ¶4. Applicant does not disagree that an examiner should acquire an understanding of the applicability of a foreign reference document during the early phases of examination. This provision however does not authorize providing a translation with a final office action or the propriety of a rejection based on a foreign language document. In fact, as prosecution in the application is closed upon the issuance of the final office action (*See* MPEP 706.07(h).III.E), Applicant is essentially foreclosed from responding.

The Decision states that “oral translations are encouraged due to the tremendous burden that would be placed upon the Translation branch if all foreign language documents that are used in prosecution were submitted for translation.” Decision, pg. 2, ¶5. Petitioner does not disagree that acquiring translations is a burden; however, it is the Office’s burden and not Applicant’s burden. The assertion requires complete disregard for the Office’s responsibility in supporting each and every rejection and appears to infer that every rejection suggested by an examiner based on a foreign language document is appropriate *ipso facto*. Rather, Petitioner considers the requirement of MPEP §901.05(d) to be internal to the Office. That is to say, rather than getting a full translation of a foreign document, the examiner should first acquire and consider an oral translation to confirm the applicability of the reference. If found applicable, the examiner must then obtain the translation and provide it to the Applicant in time for an Applicant to objectively consider its applicability and respond thereto.

The Decision maintains that “if Petitioners position was correct that no foreign language document could properly be used in a rejection unless a translation was obtained, then current pendency in the office would grow to tremendously unacceptable levels.” Decision, pg. 2, ¶5. First, the Decision implies that immediacy is more important than quality and that the Office is encouraging hasty finalization in favor of shortened pendency. Second, Applicant has not made such an assertion. Applicant agrees that if that which is claimed is disclosed in a translation of a foreign language abstract, the translation of the foreign language abstract anticipates the claim and the claim can be properly rejected under §102 -- based on the English language abstract. The Office’s Decision appears to authorize rejection of claims *carte blanche* based on foreign language documents. As discussed further below, such a suggestion has been rejected by the Board of Patent Appeals and Interferences.

Third, the Decision’s resolution of the issue improperly shifts the Office’s burden upon Applicant. The Examiner has suggested that if applicant did not consider the rejection to be

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proper and felt the need to understand the French document to respond to the rejection, applicant should have utilized their resources and limited time for response to acquire a translation of the French document. Such a position is absurd. Although pendency is every applicants concern, rejecting claims based on a foreign language document does nothing to improve pendency. Minimally, providing the translation with the initial rejection, a subsequent non-final office action, or even in the interim with an authorized response extension, is the only way that the Office can support the rejection and deal justly with an applicant. Rather, in the name of pendency, the Decision maintains that a rejection based on a foreign language document is appropriate. Again, Petitioner cannot agree that such a rationale is supported by equity or the MPEP.

The Decision further asserts that since "the French document in question was cited and submitted to the office [by the Applicant,] it is logical to assume that Applicants were at least somewhat familiar with the document in question." Decision, pg. 2, ¶5. Such an assertion is not logical at all. As referenced above, the '320 Patent was cited to Applicant in a Search Report from a foreign office. Further, the '320 Patent was not identified as an "X reference" (i.e. as being particularly relevant if taken alone). That is, the foreign office, presumably having the ability to readily appreciate the language of the foreign document itself, did not identify the '320 Patent as particularly relevant if taken alone, evidences the lacking of the '320 Patent to disclose that which is called for in the present claims. Nonetheless, Applicant's duty is to disclose that which may be considered material to patentability. Applicant did so. The Office cannot require an Applicant to order a translation of each and every reference cited by foreign offices, even ones that are not "particularly relevant when taken alone."

Board Decisions

The Board of Patent Appeals and interferences has on several occasions addressed the propriety of supporting rejections based, in whole or in part, on foreign language documents and/or translated abstracts thereof. The Decision states that "the question of finality comes down to whether the examiner introduced a new ground of rejection in the final office action" and that "in this case, the rejection did not change." Decision, pg. 2, ¶6. The Decision maintains that "The claims were rejected over the same statute and the same piece of art" and that "the examiner's position and reasoning did not change from one action to the next." Decision, pg. 3, first paragraph. The Decision further states that "the fact that Applicants did not argue the teachings of the French reference as set forth by the examiner in the non-final office action does not change the fact that the examiner has clearly established the position taken by the Office." Id.

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This assertion begs the question of how can an applicant argue the teachings if the document is provided in a foreign language? This Decision's logic is upside down. The Decision implies that if Applicant argued the teachings, then perhaps the next action would be non-final in order to obtain the translation. The Decision boldly implies that the Office's "position" and interpretation is always correct and unquestionable and therefore the Office need not supply any support for its "position" because clearly providing a non-English reference is equivalent to none at all. Petitioner cannot agree with the assertion that a rejection, supported in part by a foreign language document, clearly sets forth the basis of the rejection as required by the MPEP.

The first question is whether a rejection can be supported by an English language abstract without reliance on the underlying foreign language document. Although not precedential, *Ex parte Udayakumar* provides a concise answer to the question. Therein, the Board states that "[w]e observe that the examiner relies upon an English abstract of the Japanese Foreign reference of Yamanaka, but an English translation was not utilized nor made of record" and that "we therefore remand this application to the examiner to provide an English translation of the Japanese Foreign reference [citation omitted] and for full consideration of such English translation in connection with the art rejection of record." *Ex parte Udayakumar*, BPAI Appeal No. 2002-1205, pg. 1, ¶¶3-4. As previously stated, although Applicant does not necessarily disagree that an overly broad claim can be anticipated and/or obvious in light of an English language abstract without reliance on the underlying document, the Board appears to disapprove of such rejections without acquisition of a translation to confirm that the content of the translated abstract comports with the body of the underlying foreign language document.

The second question is whether a rejection can be supported with application of a foreign language document. Also non-precedential, *Ex parte Schade* discusses the deficiencies associated with rejecting claims over foreign language documents. In *Ex parte Schrade*, the examiner rejected several claims over an English language abstract with citation to the underlying German language document. Even though the Examiner's Answer included reference to the underlying German language document, the Board "[did] not consider[] the German-language portion of Schade because [they] could not read it." *Ex parte Schade*, BPAI Appeal No. 2001-1241, pg. 9, ¶1 (emphasis added). The Board further required that the "the Examiner should obtain a translation or English-language equivalent of Schade in order to fully evaluate its relevance to the present claims" and further stated that "[e]ven if the Examiner is fluent in technical German, and can understand the parts of Schade that are cited in Examiner's Answer, a translation would allow the rest of us who are charged with reviewing the rejection to also

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understand the reference.” Id., (emphasis added). That is, the Board recognizes that without providing a translation of the reference relied upon, there is no mutual understanding of the rejection.

Present Case

As in the case at hand, the first office action rejected the claims with reliance on the underlying French language document. Applicant's remarks in the Response of May 16, 2005 were to that portion of the reference which was available, i.e. the English language abstract. Applicant responded to that portion of the reference that was provided in English. No English reference was provided to support the rejections set forth therein. The Office provided the translation with the Final Office Action of July 19, 2005. At this point, why provide it at all? What purpose does it serve? Surely it cannot be so that Applicant can fairly respond, because this case proves that not to be allowed.

It is true that the rejection remained under the same section of the Statutes and continues to be based on the same reference. The Decision states that the question of finality is whether a rejection, based initially at least in part on a foreign language document (as in the first action), presents a new grounds of rejection when based on the translation of the underlying document (as in the final action). Decision, pg. 2, ¶6.

In Ex parte Jones 62 USPQ2d 1206, (2001), the Board states that “... obtaining translations is the responsibility of the examiner.” Ex parte Jones 62 USPQ2d 1206, at 1209, (2001), (emphasis added). Logic will dictate that such responsibility cannot be satisfied if sent to an Applicant in a final rejection. The Board further states that “[i]n the past, when neither the examiner nor the applicant relies on the underlying article, the board often expended the resources necessary to obtain a copy of the underlying scientific article, as well as translations thereof” and that “when it did so, however, the burden of examining the application fell on the board in the first instance.” Id. The Board further states, “Moreover, to the extent that the board relies on parts of a translation not previously provided to an applicant, any affirmance generally has to be a new ground of rejection [citation omitted] which can result in further prosecution.” Id. The Board is clear: reliance on parts of a translation not previously provided to an Applicant is a new grounds of rejection.

The Final Office Action of July 19, 2005, included rejections based, in whole or in part, on the translation of the '320 Patent. The Final Office Action of July 19, 2005 was also the first time the Office provided the translation of the '320 Patent. Even though the Office Action of March 22, 2005 included rejections based, in whole or in part, on the '320 Patent, the rejections

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set forth in the Final Office Action of July 19, 2005 rely, in part, on the Translation and was Applicants first opportunity to respond thereto. In accordance with the decision set forth in Ex parte Jones, the Final Office Action of July 19, 2005 included new grounds of rejection in the affirmance of a rejection based on a translation not previously provided to Applicant. As stated in MPEP §706.07(a), "subsequent actions on the merits shall be final, except where the examiner introduces a new ground of rejection that is neither necessitated by applicant's amendment of the claims nor based on information submitted in an information disclosure" MPEP §706.07(a). The Final Office Action of July 19, 2005 included new grounds of rejection not necessitated by Applicant's actions inasmuch as the translation of the '320 Patent was not provided until the Final Office Action of July 19, 2005.

Remedy Sought

For all the reasons set forth above, Petitioner believes that the finality of the Office Action of July 19, 2005 was premature and that the petition Decision of January 3, 2006 is unsupported by the present status of the law and is not sanctioned by the Office as articulated in the MPEP nor by the Board of Patent Appeals and Interference decisions cited above. As the above-captioned matter is pending appeal in light of the Notice of Appeal and Pre-Appeal Brief Conference Request of January 19, 2006, and the finality of the Office Action of July 19, 2005 is believed to be unsupportable, Petitioner respectfully requests a refund in the amount of \$1020.00 associated with the three-month extension fee paid for awaiting resolution of the Petition of September 22, 2005.

Petitioner appreciates the Office's consideration of these Remarks and cordially invites the Director to call the undersigned, should the Director consider any matters unresolved.

Respectfully submitted,

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